



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/700,704	11/24/2000	Kenichi Hirota	200062US0XPC	4539

22850 7590 10/02/2002

OBLON SPIVAK MCCLELLAND MAIER & NEUSTADT PC
FOURTH FLOOR
1755 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VA 22202

EXAMINER

KORNAKOV, MICHAEL

ART UNIT	PAPER NUMBER
----------	--------------

1746

DATE MAILED: 10/02/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/700,704

Applicant(s)

FUJISAWA

Examiner

Michael Kornakov

Art Unit

1746

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-21 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Amendment filed by Applicants *on December 29, 2000* and **not** received by the Office has not been considered at the time of the previous Non-Final Office Action, Paper No. 4, dated 04/10/2002. Therefore, at this time the previously objected and withdrawn from consideration due to improper multiple dependency claims 10-12, have now been considered and examined on the merits.
2. Applicants' amendment, Paper No. 7, has overcome rejections under 35 USC 112, second paragraph and rejections are, therefore, withdrawn.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. ^③ Claims 1, 4, 13, 14, 15, 18, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Han et al (U.S. 5,102,573).

Han discloses liquid, **caustic-free**, (alkali metal free) compositions that remove baked-on food residues from hard surfaces, which comprise:

- a) from about **1 to 40%, of a surfactant** selected from the group consisting of anionic surfactants, nonionic surfactants and mixtures thereof;
- b) from about 1 to 10% of a builder selected from the group consisting of polyphosphates, pyrophosphates, citrates, carbonates, and mixtures thereof;

Art Unit: 1746

c) from about 0.2% to 2% of an amine selected from the group consisting of monoethanolamine, diethanolamine, triethanolamine and mixtures thereof;

d) **water**;

e) from about **3 to 50%** of a solvent, which solvent is selected from the groups consisting of:

- sulfolane, propylene glycol monomethyl ether acetate, dipropylene glycol monomethyl ether acetate, ethylene glycol monoethyl ether acetate, diethylene glycol monoethyl ether acetate, diethylene glycol dimethyl ether, ethylene glycol dimethyl ether, diethylene glycol diethyl ether, and mixtures thereof;
- ii) **diethylene glycol monobutyl ether, ethylene glycol monobutyl ether, and N-methyl 2-pyrrolidone** and **mixtures thereof**; and
- iii) a mixture of two solvents, the first such solvent comprising 5-17% of an acetate selected from the group consisting of ethyl acetate and n-propyl acetate, and the **second such solvent comprising 15-34% of a solvent selected from the group consisting of acetone, N-methyl 2-pyrrolidone .**

Therefore, all the composition limitations in terms of the components and their ratios are met by Han.

5. Claims 13, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 081 355.

Art Unit: 1746

EP'355 discloses a method of cleaning and reclaiming printing screens which provide synergistic activities. Cleaning composition are also disclosed, which **contain N-methyl-2-pyrrolidone**, an oxygenated solvent, such as **butyl cellosolve (synonym for ethylene glycol monobutyl ether)** and cyclohexanone, **and a surfactant** (see abstract).

EP'455 further teaches the presence of a surfactant from **1-5% from about 30-85% of N-methyl-2-pyrrolidone and about 10-35% of oxygenated solvent (butyl celiosolve)** (see claim 9 and Examples, page 14).

With regard to an alkali content, since EP'355 utilizes the same ingredients in the same amounts as instantly claimed, therefore the composition will inherently possess all the properties as instantly claimed.

The above rejections were made in the sense of **In re Fitzgerald** or **In re Spada**, 911 F 2d 705, 709 15 USPQ 1655, 1658 (Fed. Cir. 1990), which settles that **when** the claimed compositions **are not novel**, they are not rendered patentable by recitation of properties, whether or **not** these properties are shown or suggested in prior art.

6. Claims 5 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Han in view of Griesshammer (U.S. 4,156,619).

Han does not specifically disclose the use of fluorine containing surfactant. However, Han clearly suggests that surfactant, such as anionic or nonionic **are equally operable in his invention**.

Griesshammer discloses a process for cleaning semiconductor discs by immersing the discs in a solution containing non-ionic or anionic surfactant (see abstract) The aqueous solution suitably contains from 0.3 to 5%, preferably from 0.8 to 1.5%, by weight of the cationic surfactant based on the weight of the solution. Suitable cationic surfactants are, for example, amine salts, quaternary ammonium salts, **and** **fluorine-containing surfactants based on fluorohydrocarbons**, or amphoteric surfactants according to their partly cationic character (see col. 2, lines 28-39). Therefore, based on the suggestion of Han one skilled in the art would have found it obvious to employ the fluorine containing surfactants of Griesshammer in the cleaning composition of Han in order to impart hydrophobicity to the object and/or to ensure better dissolution of halogen containing contaminants ("like dissolves like") with the reasonable expectation of success.

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP'355 in view of Griesshammer (U.S. 4,156,619).

EP'355 expressly discloses the composition of the instant claim 13, from which claim 16 directly depends. EP'355 suggests that any kind of surfactant, anionic, cationic and nonionic are operable within its scope.

The disclosure of fluorine containing surfactants of Griesshammer is discussed in paragraph 6 above and incorporated here in its entirety, as well as motivation and rationale to employ the fluorine containing surfactants of Griesshammer in lieu of any kind of surfactant suggested by EP. It is noted here that in the instant case substitution

Art Unit: 1746

of equivalent surfactants requires no express motivation, as long as the prior art recognizes equivalency, *In re Fount* 213 USPQ 532 (CCPA 1982); *In re Siebentritt* 152 USPQ 618 (CCPA 1967); *Graver Tank & Mfg. Co. Inc. V. Linde Air products Co.* 85 USPQ 328 (USSC 1950).

8. Claims 7-11, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griesshammer (U.S. 4,156,619) in view of Han.

Griesshammer discloses a method for cleaning semiconductor discs, the method comprises two basic steps: a) after discs are subjected to polishing operation they are removed and b) immersed in a cleaning solution (see abstract and col. 4, lines 4, 5). The cleaning solution of Griesshammer comprises of a non-ionic or anionic surfactant and the rest is organic solvents and or water (col. 2, lines 1,2). As solvents, both polar and non-polar solvents can be used (col. 2, lines 7-10). The temperature of cleaning process is preferably 50-80°C (col. 2, lines 22-23). Polyglycol ethers are utilized by Griesshammer in specific examples 1 and 2 in col. 3

Griesshammer **does** provide the cleaning steps with a surfactant solution at the same temperature as instantly claimed in both polar and nonpolar solvents, but **does not** disclose all the specificities of cleaning composition wherein the surfactat is present along, such solvents as ethylene glycol monobutyl ether and N-methyl-2-pyrrolidone.

Han discloses the cleaning composition, identical to that as instantly claimed for cleaning as discussed above. Since Griesshammer provides a motivation to use a surfactant solution in both polar and nonpolar solvents for cleaning semiconductor

Art Unit: 1746

discs, and since both ethylene glycol monobutyl ether and N-methyl-2-pyrrolidone are known to be part of surfactants as well as being routinely utilized solvents in cleaning processes, a person skilled in the art at the time the invention was made would have found it obvious to employ the solvents of Han in the process of Griesshammer in order to enhance the action of a surfactant and to impart the hydrophobicity to the substrate, as desired by Griesshammer, and thus to arrive at the subject matter of the instant claims.

With regard to the limitations set forth in the preamble to the instant claim 7, which recites that the byproduct to be cleaned derived from a decomposed substance from a process gas containing C and F, it is noted here that, a preamble is not accorded a significant patentable weight since it merely recites the purpose of a process or the intended use of a method, and since the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are **able to stand alone**, as per **In re Hirao**, 535 F.2d 67, 190 USPQ 15 (CCPA 1976)

With regard to the limitations of claim 8, which is concerned with the cage wherein the component to be cleaned is stored, it is noted that this limitation is an apparatus limitation, which is not even an apparatus for performing the steps of the cleaning method, and since the operation is known in reference to the object, the invention of a new machine for performing it does not make a new process, but only a new instrument for applying it. **In re Tarezy-Hornoch**, 158 USPQ 141 (CCPA 1968)

Furthermore, structural limitations of apparatus in a process, which is otherwise met by the applied reference(s), are not given a significant patentable weight, unless

Art Unit: 1746

these structural features present a manipulative difference in a process steps. In the instant case the size of a storage cage, as well as the presence of such cage does not present a manipulative difference, since the steps of the process as per (reference) can be performed without a cage.

Therefore, combination of references renders the above claims prima facie obvious and properly rejected under 35 USC 103(a).

With regard to the limitations of claim 10, its limitations are totally beyond, and are not related to the limitations of the cleaning process, as instantly claimed, but merely describe what had happen to the article much prior to the claimed cleaning process.

9. Claims 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Han et al in view of EP'355. *(as evidence)*

Han provides a composition as instantly claimed. However, disclosure of Han differs from the instant claims by not providing exact ratio of N-methylpyrrolidone and ethylene glycol monobutyl ether.

EP'355 discloses a method of cleaning and reclaiming printing screens which provide synergistic activities. Cleaning composition contains N-methyl-2-pyrrolidone, an oxygenated solvent, such as butyl cellosolve (synonym for ethylene glycol monobutyl ether) and cyclohexanone, and a surfactant (see abstract).

EP'455 teaches the presence of a surfactant from **1-5% from about 30-85% of N-methyl-2-pyrrolidone and about 10-35% of oxygenated solvent (butyl cellosolve)**. (claim 9, and Examples 1, page 14). These values are within the range of the instant

Art Unit: 1746

claims. Since both EP'355 and Han recognize the ratio of solvents as a result effective value, and EP'355 emphasizes the synergistic effect of some solvents, a person skilled in the art would have found it obvious to find an optimum ratio by routine experimentation, such as done by EP'355 to achieve the most synergistic effect for a composition of Han, and thus to arrive at the instant claim 6.

10. Claims 12 is rejected under 35 U.S.C. 103(a) over Griesshammer (U.S. 4,156,619) in view of Han and in further view of EP'355.

Griesshammer (U.S. 4,156,619) in combination with Han disclose the process of claim 7, however, they do not specify the ratio of N-methylpyrrolidone to ethylene glycol monobutyl ether.

EP'355 discloses a method of cleaning and reclaiming printing screens with solvents that provide synergistic activities.

EP'355 teaches the presence of a surfactant from **1-5% to about 30-85% of N-methyl-2-pyrrolidone and about 10-35% of oxygenated solvent (butyl cellosolve)**. (claim 9, and Examples 1, page 14). These values and ratios are within the range of the instant claims. Since EP'355 emphasizes the synergistic effect of some solvents, a person skilled in the art would have found it obvious to find an optimum ratio by routine experimentation, such as done by EP'355 to achieve the most synergistic effect for the cleaning process of Griesshammer and Han, and thus to arrive at the instant claim 12.

R s p o n s t o A r g u m n t s

11. Applicant's arguments with respect to claims 1, 4 and 6 rejected under 35 USC 102 (b) over EP'355 have been considered but are moot in view of the new ground(s) of rejection. The amendment to claim 1 has obviated the anticipation rejection.

12. Applicant's arguments with regard to Han reference have been fully considered but they are not persuasive. Applicants' arguments reside in contention that Han does not disclose N-methylpyrrolidone and ethylene glycol monobutyl ether as being usable together, but only as alternatives.

In response to this argument Applicants' attention is drawn to the abstract of Han, wherein N-methylpyrrolidone appears twice as a solvent (ii) where it can be used as alternative with ethylene glycol monobutyl ether, and as a solvent (iii), where it is used by itself, not as an alternative to an ethylene glycol monobutyl ether. Furthermore, in (ii), where only two!!!, solvents (di)-ethylene glycol monobutyl ether and N-methylpyrrolidone are used, Han explicitly teaches "or mixture thereof" (abstract, line 27). If there are only two alternative, and a mixture thereof is taught to be utilized, that means they both necessarily present.

The next Applicants argument is that Han has no example, wherein N-methylpyrrolidone and ethylene glycol monobutyl ether are used together.

In response to this it is noted that disclosed examples and preferred embodiments do not constitute a teaching away from a **broader disclosure or nonpreferred embodiments**. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971).

Art Unit: 1746

“A known or obvious composition does not become patentable. A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, **including nonpreferred embodiments**. Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also Celeritas Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998).

The crux of next Applicants arguments is that the new claims which are added by the present Amendment, Paper No.7, are not anticipated by EP'355, because the range of surfactant is 0.1 to 1.0% in the instant claims and it is about 1-5% in EP'355. Applicants further argue that term about does not anticipate the claimed ranges and recite the passage from MPEP about “sufficient specificity”.

In response to this it is noted that term **“about”** permits some tolerance, and **therefore, encompasses values on either side of the claimed value or number, *In re Pappas***, 214 F. 2d 172, 176-177, 102 USPQ 298, 301 (CCPA 1954); ***In re Vaney*** 185 F. 2d 679,683, 88 USPQ 97, 101 (CCPA 1950).

Therefore it is the Examiner' s position that the range of EP'355 “about 1%” disclose the claimed “1%” with sufficient specificity.

Claim Objections

13. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When

Art Unit: 1746

claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). The marked-up version of the Amendment, paper No. 7 contains confusing claim numbering. Clarification and/or correction is required.

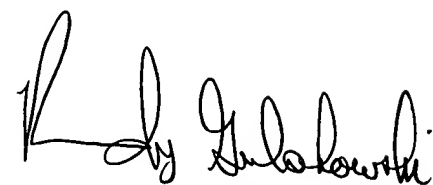
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Kornakov whose telephone number is (703) 305-0400. The examiner can normally be reached on 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (703) 308-4333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872 9310 for regular communications and (703) 872 9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 2450.

Michael Kornakov
Examiner
Art Unit 1746

MK
September 30, 2002



RANDY GULAKOWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700